

**REMARKS UNDER 37 CFR § 1.111**

**Formal Matters**

Claims 2, 3, 7-9, 11, 12, 14, 17-40 and are pending after entry of the amendments set forth herein.

Claims 1-22 were examined. Claims 1-22 were rejected. No claims were allowed.

Please add new claims 37-40 as provided above.

No new matter has been added.

As requested by the office action, applicant confirms that amended claims 33-40 have been renumbered as claims 15-22.

**Double Patenting Rejection**

The rejection of claims 15-22 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 5,727,969 to Bennetti et al. ("Bennetti") in view of U.S. Patent No. 5,782,746 to Wright ("Wright") is respectfully traversed. Claims 15 and 16 have been canceled, rendering their rejection moot. However, with respect to claims 17-22, Bennetti does not claim a dome shaped housing or a device consisting of a pair of interlinked shafts having suction port assemblies, therefore the present invention is clearly distinguishable from the device claimed in Bennetti. For this reason, the present rejection towards the described invention should be withdrawn.

The rejection of claim 16 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of Bennetti in view of the Roux et al. article entitled "New Helper Instrument in Cardiac Surgery," is also respectfully traversed. Claim 16 has been canceled, thus rendering the rejection moot.

**Rejection under 35 U.S.C. § 102 (e)**

The rejection of claims 1-22 under 35 U.S.C. § 102 (e) as being anticipated by Wright are respectfully traversed. Wright describes an annular or U-shaped device for the immobilization of the heart surface by means of negative pressure. Wright, however, does not teach or suggest a dome shaped device. Furthermore, applicant respectfully disagrees with the statement on page 3 of the outstanding office action stating that the described device under Wright is dome-shaped. Wright makes clear that the described device is annular with inner and outer rings that form seals with the heart surface, whereby partial vacuum is applied to the area between the seals. Newly submitted claim 23 substantially incorporates the vocabulary of claims 1 and 6 as originally presented. Claim 23 as now presented contains only the limitations of originally filed claims 1 and 6. Thereby this amendment does not narrow the scope of claim 6 (now claim 23) within the meaning of *Festo*. Claim 2, 7, 8 have been amended to depend from new claim 23 and are also allowable, for at least the same reasons.

The rejection of claims 1-14 and 16 under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 5,927,284 to Borst et al. ("Borst") is respectfully traversed. The device of Borst consists of a suction pad attached to a semi-rigid arm, whereby two devices are placed on the heart surface in parallel to each other. Furthermore, the semi rigid arms of the two devices are not attached or closely associated to one another in any form. This is clearly distinguishable from the present invention, which makes clear that the rigid arms holding the suction port assemblies are associated to one another by means of an articulating link at an intermediate location along the shafts, as inserted in claim 37. It is respectfully submitted that Borst clearly fails to disclose or suggest a pair of shafts interlinked by an articulating link.

**Rejection Under 35 U.S.C § 103 (a)**

The rejection of claims 15 and 17-22 under 35 U.S.C. § 103 (a) as unpatentable over Borst in view of Wright is respectfully traversed. As previously stated, Wright does not disclose or suggest a dome shaped device. Wright describes an annular apparatus that rests upon the heart surface and stabilizes the area of the heart at the center of the annulus for surgical procedures. Furthermore, the device disclosed in Wright does not possess suction ports, rather, the device consists of a relatively flat annular element that rests upon the heart surface, whereby the inner and outer edges form a seal with the

heart surface, and subsequently vacuum pressure is applied to the entire area in between the two concentric edges of the annular device. Alternatively, Borst describes a paddle-shaped suction device that is attached to a semi-rigid arm. There is no suggestion in either of the cited references that would lead one of ordinary skill in the art to replace the paddle of Borst with a dome-shaped housing, even if Wright did disclose a dome-shaped housing, which it does not. For this reason, the present rejection towards the described invention should be withdrawn.

Applicant notes that in rewriting the claims in this manner, that the claims have not been narrowed from their previous scope since all the limitations now expressly set forth were previously implicit to the claims before. The cited references do not disclose or suggest either a dome shaped housing or a pair of shafts interlinked by an articulating link. Therefore, new claims 23 and 24 submitted herewith are in condition for allowance.

Newly presented claims 38-40 recite method steps for accessing a surface of the heart, providing an instrument having first and second shafts joined by an articulating link, with each shaft being attached to a member having at least one suction port, contacting the member with the surface of the heart, applying negative pressure to attach the member to the surface of the heart, and manipulating the interlinked shafts through the articulating link to move the members with respect to one another, while the members remain attached to the heart. It is respectfully submitted that none of the art of record, whether taken individually or in any proper consideration, teaches, discloses or renders obvious the recited method steps of claims 38-40.

### **Conclusion**

In view of the above amendments and remarks as well as the amendments and remarks made in the Amendment filed July 18, 2002, Applicant respectfully requests reconsideration of the outstanding office action.

Applicant submits that all of the claims are in condition for allowance, which such action is earnestly solicited. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-0815, order number GUID-003DIV2.

Respectfully submitted,  
BOZICEVIC, FIELD & FRANCIS LLP

Date: \_\_\_\_\_

*July 29 2002*

By: \_\_\_\_\_



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